

ESTTA Tracking number: **ESTTA226342**

Filing date: **07/25/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	MD Video, Inc.		
Entity	Corporation	Citizenship	Florida
Address	12301 SW 68th Court Miami, FL 33156 UNITED STATES		

Attorney information	Michael E. Tschupp Kluger, Peretz, Kaplan & Berlin, P.L. 201 S. Biscayne Blvd. 17th Floor Miami, FL 33131 UNITED STATES trademarks@kpkb.com Phone:305-379-9000
----------------------	---

Registration Subject to Cancellation

Registration No	2599776	Registration date	07/23/2002
Registrant	healthcommunities.com, Inc. 136 West Street, Suite 201 Northampton, MA 01060 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 2002/02/25 First Use In Commerce: 2002/02/25 All goods and services in the class are cancelled, namely: Medical information, namely, providing information on a variety of medical topics using prerecorded video programs accessible by computer on the Internet
--

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Attachments	MD Video, Inc.'s Petition for Cancellation (M0570922).PDF (5 pages)(29781 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

Signature	/Michael E. Tschupp/
Name	Michael E. Tschupp
Date	07/25/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

MD VIDEO, INC.,

Cancellation No.

Petitioner,

v.

PETITION FOR CANCELLATION

In re Reg. No.: 2,599,776

HEALTHCOMMUNITIES.COM, INC.,

Owner.

PETITION FOR CANCELLATION

Petitioner, MD Video, Inc. (“MD Video”), a Florida corporation with its principal place of business located at 12301 S.W. 68th Court, Miami, Florida 33156, believes that it is or will be damaged by Registration No. 2,599,776 (the “Contested Registration”), and accordingly hereby petitions to cancel such registration pursuant to 15 U.S.C. § 1064, and alleges:

Introduction

1. This petition seeks cancellation of the Contested Registration on two grounds. First, the mark claimed in the Contested Registration has been abandoned by Healthcommunities.com, Inc. (the “Registrant”). Second, upon information and belief, the Registrant made material misrepresentations to the United States Patent and Trademark Office (“USPTO”) in its Declaration of Use of Mark in Commerce Under Section 8, filed July 1, 2008 (the “Declaration”), because it falsely represented to the USPTO that the Contested Mark was in commercial use, when in reality, it knew, or should have known, that the Contested Mark was not in commercial use when it filed the Declaration.

The Contested Registration

2. Upon information and belief, Registrant is a Massachusetts corporation with its principal place of business at 136 West Street, Suite 201, Northampton, Massachusetts 01060.

On July 23, 2002, Registrant obtained a registration on the Supplemental Register for the mark MD VIDEO (the “Contested Mark”) in International Class 42 for the following services:

Medical information, namely, providing information on a variety of medical topics using prerecorded video programs accessible by computer on the Internet.

The Contested Registration lists the dates of first use of the Contested Mark, anywhere and in commerce, as February 25, 2002.

3. On July 1, 2008, Registrant filed a purported specimen of the Contested Mark, which claims to demonstrate the Contested Mark’s ongoing use in commerce with respect to the above-listed services on a website located at www.myhealthsite.com. On July 1, 2008, Registrant also filed its Declaration, in which Registrant declared that it is using the mark in commerce in connection with these services.

4. A review of the website www.myhealthsite.com, however, reveals that the Contested Mark is not used in relation to providing any prerecorded medical video programs. The website contains a separate and distinct mark, PATIENT VIDEO,¹ which links to a different website, www.patientvideo.com, where prerecorded medical video programs are purported to be available; however, no such video programs are actually accessible on that website either.²

MD Video’s Application for Registration

5. MD Video has used the mark VIDEOMD and Design in commerce since as early as December 21, 2007 in connection with providing information on a variety of medical topics using streaming video over the internet. On October 16, 2007, MD Video applied for registration of the mark VIDEOMD and Design (Serial No. 77305015) in connection with the

¹ PATIENT VIDEO was registered by the Registrant on August 20, 2002 (Registration No. 2,610,929).

² The portion of the www.patientvideo.com website that purports to offer videos (but contains no functioning videos) has apparently not been modified for over five years (each video web page states: “This page last modified: Wednesday, 11-Dec-2002”).

above-stated services. On January 29, 2008, the registration was refused based on a finding of likelihood of confusion with the Contested Registration pursuant to § 2(d) of the Lanham Act.³

Cancellation Based on Abandonment

6. Upon information and belief, Registrant has either never used, or has discontinued use of the Contested Mark on or in connection with the services covered by the Contested Registration, with an intent not to resume such use. This constitutes abandonment of the Contested Mark under Trademark Act Section 45, 15 U.S.C. § 1127.

7. Upon information and belief, Registrant has not used the Contested Mark for the services covered by the Contested Registration within the past three consecutive years. Such non-use constitutes prima facie evidence of abandonment of the mark for such services, under Trademark Act Section 45, 15 U.S.C. § 1127.

8. Accordingly, the Contested Registration should be canceled for the reasons set forth above.

Cancellation Based on Fraud

9. In its Declaration, Registrant declared that it is using the Contested Mark in commerce on or in connection with “[m]edical information, namely, providing information on a variety of medical topics using prerecorded video programs accessible by computer on the Internet.”

10. Upon information and belief, this statement was false because, as described above, the Contested Mark is not used in commerce or in connection with providing medical information using prerecorded video programs accessible over the Internet. Furthermore, the specimen submitted by Registrant in support of the Declaration gives the false impression that the Contested Mark is in use for the services in question, when in reality it is not. These

³ MD Video does not believe its mark is likely to be confused with the Contested Mark and reserves all rights in this respect.

misrepresentations were material because Registrant's use of the Contested Mark as described in the registration is a requirement to maintaining the Contested Registration.

11. Registrant therefore made false representations of material fact to the USPTO in its Declaration. Such misrepresentations are grounds for cancellation of the registration. *See Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46 (Fed. Cir. 1986). Registrant knew or should have known the statement was false because it was aware, or should have been aware, that the Contested Mark is not used in commerce or in connection with the described services, and that its specimen did not evidence such use.

12. Accordingly, the Contested Registration should be canceled for the reasons set forth above.

The Harm to MD Video

13. If Registrant is permitted to continue to maintain its Contested Registration, it will continue to enjoy a presumption of an exclusive right to use the Contested Mark in commerce. Further, the continued existence of such registration casts a shadow upon MD Video's right to continue to use, develop and expand the use of its VIDEOMD mark in the United States as evidenced by the USPTO's refusal to register the mark. The Contested Registration is thus a source of damage and injury to Video MD.

WHEREFORE, Petitioner, MD Video, Inc., respectfully requests that Registration No. 2599776 be cancelled on the grounds that it is not in use in commerce and has therefore been abandoned and because it was procured by fraud.

Respectfully submitted,
KLUGER, PERETZ, KAPLAN & BERLIN, P.L.
Attorneys for Petitioner
Miami Center, Seventeenth Floor
201 So. Biscayne Blvd.
Miami, Florida 33131
Telephone: (305) 379-9000
Facsimile: (305) 379-3428

By: /Michael E. Tschupp/
Michael B. Chesal
Michael E. Tschupp (Reg. No. 55,895)
Paul L. Kobak

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 25th day of July, 2008, the foregoing is being served via Express Mail upon Registrant, Healthcommunities.com, Inc., 136 West Street, Suite 201, Northampton, Massachusetts 01060.

/Michael E. Tschupp/
Michael E. Tschupp (Reg. No. 55,895)